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PTO/SB/21 (09-04) (AW 10/2004)
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Total Number of Pages in This Submission

Application Number	10/511,010
Filing Date	10/12/2004
First Named Inventor	Christoph Voss
Art Unit	3683
Examiner Name	Vu Q. Nguyen
Attorney Docket No.	PC10413US

ENCLOSURES *(Check all that apply)*

- ☒ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/Declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation, Change of Correspondence Address
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  - ☐ Landscape Table on CD
- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☒ Appeal Communication to TC (**Appeal Brief**)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below): PTO-2038; post card receipt

Remarks:

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm Name	RatnerPrestia		
Signature			
Printed Name	Christopher A. Rothe		
Date	8/30/2007	*Registration No.*	54,650

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Typed or Printed Name	Denise Morgan	*Date*	8/30/2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Office, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, ALEXANDRIA, VA 22313-1450.**

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PTO/SB/17 (12-04v2) (AW 1/2005)
Approved for use through 7/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Effective on 12/08/04.
Fees Pursuant to the Consolidated Appropriations Act. 2005 (H.R. 4818).

FEE TRANSMITTAL For FY 2007

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 500.00

Complete if Known	
Application Number	10/511,010
Filing Date	10/12/2004
First Named Inventor	Christoph Voss
Examiner Name	Vu Q. Nguyen
Art Unit	3683
Attorney Docket No.	PC10413US

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

	FILING FEES		SEARCH FEES		EXAMINATION FEES		
		Small Entity		Small Entity		Small Entity	
Application Type	Fee ($)	Fee ($)	Fee ($)	Fee ($)	Fee ($)	Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	____
Design	200	100	100	50	130	65	____
Plant	200	100	300	150	160	80	____
Reissue	300	150	500	250	600	300	____
Provisional	200	100	0	0	0	0	____

2. EXCESS CLAIM FEES

Fee Description	Small Entity Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims		Extra Claims		Fee ($)		Fee Paid ($)	Multiple Dependent Claims Fee ($)	Multiple Dependent Claims Fee Paid ($)
_____	- 20 or HP =	_____	x	_____	=	_____	____	____

HP = highest number of total claims paid for, if greater than 20

Indep. Claims		Extra Claims		Fee ($)		Fee Paid ($)
_____	- 3 or HP =	_____	x	_____	=	_____

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

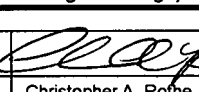
Total Sheets		Extra Sheets		Number of each additional 50 or fraction thereof		Fee ($)		Fee Paid ($)
_____	- 100 =	_____	/ 50 =	_____	(round up to a whole number) x	_____	=	____

4. OTHER FEE(S)

	Fees Paid ($)
Non-English Specification, $130 fee (no small entity discount)	____
Other (e.g., late filing surcharge): Filing a brief in support of an appeal	500.00

SUBMITTED BY

Complete *(if applicable)*

Signature		Registration No. Attorney/Agent)	54,650	Telephone	610-407-0700
Name (Print/Type)	Christopher A. Rothe			Date	8/30/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/511,010
Applicant: Christoph Voss
Filed: October 12, 2004
Title: ELECTOMAGNETIC VALVE, ESPECIALLY FOR SLIP REGULATED MOTOR VEHICLE BRAKE SYSTEMS
T.C./A.U.: 3683
Examiner: Vu Q. Nguyen
Confirmation No.: 6911
Notice of Appeal Filed: July 12, 2007
Docket No.: PC10413US

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

S I R :

Appellant hereby requests consideration and reversal of the rejection of claims 14-27 set forth in the Final Rejection dated April 12, 2007 ("Final Rejection"), and the Advisory Action dated June 22, 2007 ("Advisory Action").

I. REAL PARTY IN INTEREST

The real party in interest in this matter is Continental Teves AG & Co. OHG, a subsidiary of Continental AG, by virtue of an assignment recorded on October 12, 2004, at Reel/Frame 016545/0757.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences related to the subject matter of this Appeal.

III. STATUS OF CLAIMS

Claims 1-13 have been cancelled. Claims 14-27 stand rejected and are being appealed. Claim 14 is the only independent claim.

IV. STATUS OF AMENDMENTS

Applicant filed amendments to the specification subsequent to the Final Rejection to correct minor informalities related to reference numbers. The claims were not amended subsequent to the Final Rejection.

The Advisory Action does not indicate whether the amendments to the specification were considered or entered. Therefore, the status of the amendments to the specification is uncertain.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The following summary of independent claim 14 is provided with exemplary references to Applicant's substitute specification and Figure 1 for purposes of illustrating one possible embodiment of the claimed invention.

Referring to the example described in Applicant's substitute specification and Figure 1, claim 14 is directed to an electromagnetic valve that includes a valve housing (1). (Para. [0004], lines 1-2). A first valve closure member (7) and a second valve closure member (8) are arranged in the valve housing (1). (Para. [0004], lines 16-23). First valve closure member (7) opens and closes a first valve passage (5), second valve closure member (8) opens and closes a second valve passage (6). (Para. [0004], lines 16-19; Para. [0005], lines 1-4). A pressure fluid inlet (13) and a pressure fluid outlet (19) open into the valve housing (1). (Para. [0007], lines 1-5). The first valve closure member (7) opens and closes the first valve passage (5) positioned in the second valve closure member (8) in response to the an electromagnetic excitation of a valve coil. (Para. [0005], lines 4-7). The second valve closure member (8) opens the second valve passage (6) under the influence of a spring (17) exclusively in the open position of the first valve passage (5) so that pressure fluid prevailing in the pressure fluid inlet propagates to the pressure fluid outlet along a flow route inside the valve housing. (Para. [0005], lines 1-7). The spring (17) is placed outside the flow route, and the valve includes

a bowl-shaped stop (3) fixedly secured in a housing step (24) inside the valve housing (1) remote from the flow route. (Para. [0008], lines 1-6). The stop (3) has a bottom wall and an opening through the bottom wall through which the second valve closure member (8) extends. (Para. [0008], lines 8-10). The stop (3) circumscribes a portion of the second valve closure member (8) and forms an annular space between the stop and the second valve closure member. (Figure 1). The spring (17) is seated on the bottom wall in the annular space between the stop (3) and second valve closure member (8). (Figure 1).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Rejection of claims 14-18, 21, 22, 24, 25 and 27 under 35 U.S.C. § 102(b) as being anticipated by German Patent DE 19836493 ("Obersteiner, et al."), for which U.S. Patent No. 6,435,210 is relied on as an English equivalent.

B. Rejection of claims 19, 20 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Obersteiner et al. in view of U.S. Patent No. 5,810,330 ("Eith et al.").

C. Rejection of claims 14-18, 21, 22 and 24-27 under 35 U.S.C. § 103(a) as being unpatentable over German Patent DE 10010734 ("Holl, et al.") in view of Obersteiner et al.

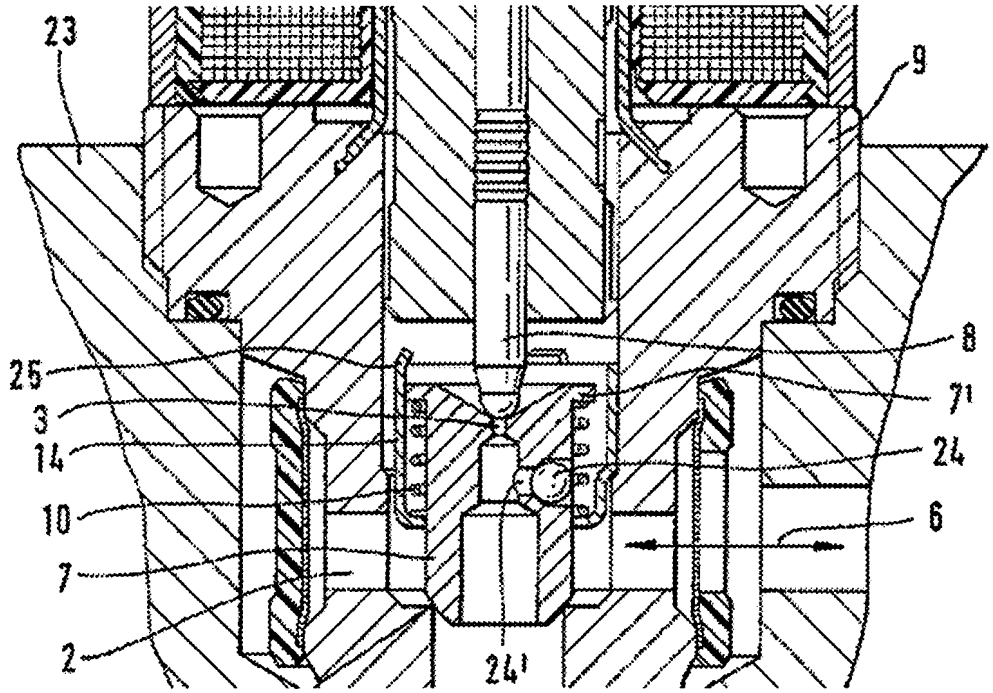
D. Rejection of claims 19, 20 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Holl et al. in view of Obersteiner et al. and further in view of Eith et al.

VII. ARGUMENT

It is respectfully submitted that claims 14-27 are patentable over the art of record for the reasons set forth below.

A. CLAIMS 14-18, 21, 22, 24, 25 and 27 ARE NOT ANTICIPATED BY OBERSTEINER, ET AL. BECAUSE OBERSTEINER ET AL. FAILS TO TEACH EACH AND EVERY ELEMENT OF THE CLAIMS.

Independent claim 14 recites an electromagnetic valve that includes "a bowl-shaped stop fixedly secured in a housing step inside the valve housing remote from the flow route." Applicant and Examiner disagree as to whether a sleeve (14) shown in Fig. 2 of Obersteiner is "fixedly secured" in a housing (9). An excerpt from Fig. 2 showing the sleeve (14) and housing (9) is provided below.



The Examiner contends that sleeve (14) constitutes "a bowl-shaped stop fixedly secured in a housing step inside the valve housing" as recited in Applicant's claim 14. The Examiner cites to column 4, lines 2-5 of the specification for support. A proper reading of the cited passage indicates that sleeve (14) is not "fixedly secured" in housing (9). According to the cited passage, "sleeve 14 ***is guided*** at least partially along a wall of the bore in the valve housing 9 and is simultaneously positioned in abutment on a small housing step." (Col. 4, lines 2-5) (emphasis added). This is the only passage in Obersteiner et al. that discusses the physical mobility of the sleeve (14). The phrase "is guided" confirms that sleeve (14) is free

to move in housing (9). If sleeve (14) can move, it is not "fixedly secured" in a housing step, as recited in claim 14.

The cited passage in Obersteiner et al. also states that sleeve (14) "is simultaneously positioned in abutment on the housing step." Sleeve (14) abuts the housing step, nothing more. That fact alone does not "fixedly secure" the sleeve in the housing step. Such a conclusion would disregard the first part of the cited passage, which indicates that sleeve (14) is movable.

The only other evidence relevant to the fixation or mobility of the sleeve is Fig. 2 itself. As shown in the above Figure, sleeve (14) is unrestrained both axially and radially on the left side of the bore. The bottom opening of sleeve (14) also appears larger than the diameter of piston (7), presumably allowing lateral movement of the sleeve. The Examiner provides no opposing evidence that shows that the sleeve is fixedly secured, and one of ordinary skill in the art can not form such a conclusion from Fig. 2.

The Examiner contends that, although Obersteiner et al. describes the sleeve (14) as being "guided" along the bore, the guiding only takes place during assembly, and the sleeve is fixed during operation. There is no evidentiary support for these assumptions. The paragraph describing how the sleeve is "guided" focuses extensively on the operation and function of the valve, not the assembly of the components. The sentence referring to the spring (10) is no exception, because it describes how the spring prevents the valve ball (24) from dropping out of piston (7) during operation - and only mentions that it is slipped upon the valve as an aside. (Col. 3 line 66 - Col. 4 line 2). Therefore, it is more logical to assume that the phrase "guided" refers to the sleeve's functional operation.

Assuming for the moment that the phrase "guided" could refer to either assembly or operation of sleeve (14), a significant ambiguity exists in the description. One can not infer that the sleeve (14) is fixed, because of this ambiguity.

Even if the phrase "guided" were to refer only to the sleeve's mobility during assembly, there is still no evidence that the sleeve becomes fixedly secured after

assembly. There are no statements in the specification that expressly state or imply that the sleeve is fixedly secured. The Examiner assumes that the sleeve must be fixedly secured because "there is no disclosure of any functionality regarding movement of the sleeve." The fact that Obersteiner et al. fails to explain the reason for the sleeve's mobility does not mean that the sleeve must be fixedly secured. Applicant respectfully submits that it is the Patent Office's burden to present evidence that shows that sleeve (14) is fixedly secured, and this burden has not been met.

If "fixedly secured" is interpreted to cover movable objects, then the "fixedly secured" feature of claim 14 is being ignored. A "bowl-shaped stop *fixedly secured* in a housing step" would be no different from a "bowl-shaped stop in a housing step" under such a construction. The Patent Office can not ignore express limitations in a claim. *See Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532, 3 USPQ2d 1321, 1324 (Fed. Cir. 1987).

For all of the foregoing reasons, Obersteiner et al. does not disclose "a bowl-shaped stop fixedly secured in a housing step inside the valve housing." Because this feature is not shown in Obersteiner et al., Applicant submits that claim 14 is allowable over Obersteiner et al. Claims 15-18, 21, 22, 24, 25 and 27 are dependent on claim 14 and incorporate all the elements recited in claim 14. Therefore, claims 15-18, 21, 22, 24, 25 and 27 are allowable over Obersteiner, et al for at least the same reasons that claim 14 is allowable. Applicant respectfully submits that the rejection of claims 14-18, 21, 22, 24, 25 and 27 under 35 U.S.C. § 102(b) based on Obersteiner et al. should be reversed.

B. CLAIMS 19, 20 AND 23 ARE NOT UNPATENTABLE OVER OBERSTEINER, ET AL. IN VIEW OF EITH ET AL., BECAUSE THE COMBINATION OF OBERSTEINER ET AL. AND EITH ET AL. FAILS TO TEACH EACH AND EVERY ELEMENT OF THE CLAIMS.

MPEP § 2143 states:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

> or to combine reference teachings. Second, there must be a reasonable expectation of success. ***Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.***

MPEP § 2143 (emphasis added).

Claims 19, 20 and 23 are dependent on claim 14 and incorporate all the elements recited in claim 14, including "a bowl-shaped stop fixedly secured in a housing step inside the valve housing remote from the flow route." Obersteiner et al. is the only reference that is cited for the alleged disclosure of a "a bowl-shaped stop fixedly secured in a housing step inside the valve housing remote from the flow route." Because Obersteiner et al. does not teach this element of claims 19, 20 and 23, the combination of Obersteiner et al. and Eith et al. fails to teach all the elements of the rejected claims. The Patent Office has thus failed to establish a *prima facie* case of obviousness for claims 19, 20 and 23. Accordingly, Applicant respectfully submits that the rejection of claims 19, 20 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Obersteiner et al. in view of Eith et al. should be reversed.

C. CLAIMS 14-18, 21, 22 AND 24-27 ARE NOT UNPATENTABLE OVER HOLL ET AL. IN VIEW OF OBERSTEINER, ET AL. BECAUSE THE COMBINATION OF HOLL ET AL. AND OBERSTEINER ET AL. FAILS TO TEACH EACH AND EVERY ELEMENT OF THE CLAIMS.

Claims 15-18, 21, 22 and 24-27 are dependent on claim 14 and incorporate all the elements recited in claim 14, including a "a bowl-shaped stop fixedly secured in a housing step inside the valve housing remote from the flow route." As noted above, Obersteiner et al. is the only reference that is cited for the alleged disclosure of a "bowl-shaped stop fixedly secured in a housing step inside the valve housing remote from the flow route." Because Obersteiner et al. does not teach this element, the combination of Holl et al. and Obersteiner et al. does not teach each and every element of claims 14-18, 21, 22 and 24-27. Therefore, the Patent Office has failed to establish a *prima facie* case of obviousness for claims 14-18, 21, 22 and 24-27. Applicant respectfully submits that the rejection of claims 14-18, 21, 22 and 24-27 under 35 U.S.C. § 103(a) as being unpatentable over Obersteiner et al. in view of Eith et al. should be reversed.

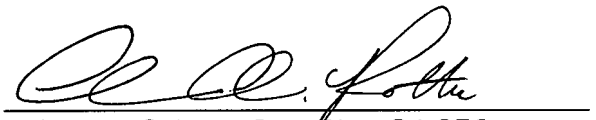
D. CLAIMS 19, 20 AND 23 ARE NOT UNPATENTABLE OVER HOLL ET AL. IN VIEW OF OBERSTEINER, ET AL. IN VIEW OF EITH ET AL. BECAUSE THE COMBINATION OF HOLL ET AL., OBERSTEINER ET AL. AND EITH ET AL. FAILS TO TEACH EACH AND EVERY ELEMENT OF THE CLAIMS.

Claims 19, 20 and 23 are dependent on claim 14 and incorporate all the elements recited in claim 14, including a "a bowl-shaped stop fixedly secured in a housing step inside the valve housing remote from the flow route." As noted above, Obersteiner et al. is the only reference that is cited for the alleged disclosure of a "bowl-shaped stop fixedly secured in a housing step inside the valve housing remote from the flow route." Because Obersteiner et al. does not teach this element, the combination of Holl et al., Obersteiner et al. and Eith et al. does not teach each and every element of claims 19, 20 and 23. Therefore, the Patent Office has failed to establish a *prima facie* case of obviousness for claims 19, 20 and 23. Applicant respectfully submits that the rejection of claims 19, 20 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Holl et al. in view of Obersteiner et al. and further in view of Eith et al. should be reversed.

E. CONCLUSION

Applicant respectfully submits that the rejection of claims 14-18, 21, 22, 24, 25 and 27 under 35 U.S.C. § 102(b) are not supported by the evidence of record. Moreover, Applicant respectfully submits that the Final Rejection and Advisory Action have failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) for claims 14-27. Accordingly, Applicant respectfully requests the Board's reversal of all of the claim rejections.

Respectfully submitted,



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Denise Morgan

VIII. CLAIMS APPENDIX

Claims involved in the appeal:

14. An electromagnetic valve for slip-controlled motor vehicle brake systems, comprising:

a valve housing and a first and a second valve closure member arranged in the valve housing and being able, in a coaxial arrangement in the valve housing, to open or close a first and a second valve passage, including a pressure fluid inlet and a pressure fluid outlet opening into the valve housing, with the first valve closure member being able to open or close the first valve passage positioned in the second valve closure member in response to an electromagnetic excitation of a valve coil, and with the second valve closure member opening the second valve passage under the influence of a spring exclusively in the open position of the first valve passage so that pressure fluid prevailing in the pressure fluid inlet propagates to the pressure fluid outlet along a flow route inside the valve housing in which the first and the second valve passage are positioned, wherein the spring is placed outside the flow route, the valve comprising a bowl-shaped stop fixedly secured in a housing step inside the valve housing remote from the flow route, the stop having a bottom wall and an opening through the bottom wall through which the second valve closure member extends, the stop circumscribing a portion of the second valve closure member and forming an annular space between the stop and the second valve closure member, the spring being seated on the bottom wall in the annular space between the stop and second valve closure member.

15. An electromagnetic valve as claimed in claim 14, wherein the stop is arranged above a transverse bore opening into the valve housing and being connected to the pressure fluid inlet.

16. An electromagnetic valve as claimed in claim 15, wherein the stop is provided at a housing step of the valve housing that is positioned above the transverse bore and whose inside diameter is adapted to the outside diameter of the stop.

17. An electromagnetic valve as claimed in claim 15,

wherein the stop is configured as a sleeve-shaped bowl in whose interior an end of the spring is supported on a bowl bottom, the stop being positioned with its outside surface on a housing step disposed above the transverse bore in the valve housing.

18. An electromagnetic valve as claimed in claim 17,

wherein the stop has a bowl edge remote from the bowl bottom that is angled off in a radial outward direction and bears against the inside wall of the valve housing.

19. An electromagnetic valve as claimed in claim 17,

wherein an annular chamber is provided between the outside periphery of the sleeve-shaped bowl and the inside wall of the sleeve-shaped valve housing, establishing a permanent pressure fluid connection between the pressure fluid inlet and a magnet armature chamber through pressure compensating openings arranged in the valve housing and in the sleeve-shaped bowl.

20. An electromagnetic valve as claimed in claim 19, wherein the spring extends vertically inside the annular chamber.

21. An electromagnetic valve as claimed in claim 17,

wherein an end of the spring remote from the bowl bottom bears against a bead of the piston-shaped second valve closure member extending through an opening in the bowl bottom towards a valve seat member that is press-fitted below the transverse bore into the valve housing.

22. An electromagnetic valve as claimed in claim 21,

wherein the second valve closure member is manufactured as a turned part from free-cutting steel.

23. An electromagnetic valve as claimed in claim 17,

wherein the stop and the valve housing consist of a deepdrawn thin sheet having pressure compensating openings, wherein the pressure compensating openings and the transverse bore are punched or impressed therein.

24. An electromagnetic valve as claimed in claim 14,

wherein the valve housing has a one-part design, and its open sleeve end remote from the second valve passage is closed by a plug acting as a magnet core and being configured as a cold-heading or extruded part.

25. An electromagnetic valve as claimed in claim 14,

wherein the second valve passage is provided in a disc-shaped or sleeve-shaped valve seat member being configured as a turned part or cold-heading part.

26. An electromagnetic valve as claimed in claim 14,

wherein the second valve closure member is designed as a sleeve bowl made in a deepdrawing operation, the bowl bottom accommodating the first valve passage cooperating with the first valve closure member, and in that close to the bowl bottom the peripheral surface of the second valve closure member is penetrated by transverse bores which are positioned in the horizontal plane of a transverse bore connected to the pressure fluid inlet to form a flow route with least possible rerouting, said transverse bore extending through the valve housing in a horizontal direction.

27. An electromagnetic valve as claimed in claim 14, wherein the second valve closure member further comprises a hollow bottom portion penetrated by at least one transverse bore extending in a horizontal plane through the bottom portion.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.